

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: ANTHONY R. ROTHCHILD

Serial No.: 09/755,541

Filed: January 5, 2001

Title: SYSTEM AND METHOD FOR ADDING
AN ADVERTISEMENT TO A PERSONAL
COMMUNICATION

Art Unit: 3622

Examiner: Jeffrey D. Carlson

CORRECTED APPEAL BRIEF

Mail Stop: Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reference to the above-identified application, Appellant hereby submits a Corrected Appeal Brief pursuant to 37 C.F.R. § 41.37, and in response to the Notification of Non-Compliant Appeal Brief, mailed on May 27, 2010. Appellant respectfully submits that this Corrected Appeal Brief is timely filed under 37 C.F.R. §§ 41.37(a)(1) and (e), and the Corrected Appeal Brief meets the substantive requirements of § 41.37(c)(1). Appellant requests entry, consideration, and favorable action on this appeal at the Board's earliest convenience.

In accordance with § 41.37(c)(1), Appellant presents the following items under the headings prescribed therein.

Real Party in Interest

Anthony R. Rothschild, a citizen of the United Kingdom, owns the subject application.

Related Appeals and Interferences

The Appellant is not aware of any other appeals or interferences that would bear on the Board's decision in this appeal.

Status of Claims

On December 10, 2009, the Appellant filed a Notice of Appeal from the final rejections of pending Claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90 and 92-95 as stated in the Office Action mailed on August 10, 2009 (hereinafter the "Final Action"). Claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90 and 92-95 stand rejected, and Claims 1-61, 63, 64, 66, 67, 71, 72, 74, 78-80, 82, 83, 85 and 91 were previously cancelled.

Status of Amendments

No claim amendments are currently proposed and (to the best of Appellant's understanding) none have been denied entry.

Summary of the Claimed Subject Matter

The present invention is directed toward a system and method for adding an advertisement to a personal communication. Specifically, as shown in Figures 1 and 2,

the system (10) comprises a Web site (110), a sender device (120) and a recipient device (130), wherein the Web site (110) is in communication with the sender device (120) and the recipient device (130) via a wide area network (102) (e.g., the Internet), and comprises a server (112), an advertising application (114) and a memory device (116). In one embodiment of the present invention, the advertising application (114) is configured to (i) automatically select an advertisement from a plurality of advertisements, (ii) insert the advertisement into an email, and (iii) send the email to the recipient device.

In another embodiment of the present invention, the advertising application is further configured to ***use at least a portion of the content of the email to select an advertisement from a plurality of advertisements***, wherein the sender is compensated for allowing the advertisement to be inserted into the email. Such a system is advantageous over the prior art in that it provides advertisements for products to consumers that are more likely to be interested in the products. The system does this by inserting advertisements into emails that are related to the content of the email. For example, an advertisement for Nike™ may be inserted into an email concerning sports (e.g., an email asking the recipient whether he/she would like to go to a football game with the sender).

Support for each of the limitations of Claims 62, 68, 75, 81, 87 and 92 (i.e., the independent claims) can be found in the specification and drawings as indicated below:

62. A Web host connected to a wide area network (WAN), comprising:
a Web server adapted to communicate with a plurality of network devices
via said WAN **{see, e.g., Fig. 1, ref. no. 110; Fig. 2, ref. no. 112; p. 11, ll. 13-22; and p. 12, ll. 1-8};**

a memory device connected to said Web server and adapted to store a
plurality of advertisements **{see, e.g., Fig. 2, ref. no. 116; p. 12, ll. 1-4; and p. 15, ll. 7-15};** and

an advertising application **{see, e.g., Fig 2, ref. no. 114; and p. 12, ll. 1-8}**, wherein said advertising application provides the functions of:

permitting a sender to submit communication data to said Web host
and to identify at least one recipient of said communication data **{see, e.g., Fig. 3, ref. no. 304; Fig. 4, ref. nos. 406-410; Fig. 5, ref. no. 508; p. 14, l. 21 - p. 15, l. 6; p. 16, l. 19 - p. 17, l. 5};**

using at least a portion of the content of said communication data to
automatically select at least one advertisement from said plurality of
advertisements **{see, e.g., p. 16, l. 19 - p. 17, l. 5};**

inserting said at least one advertisement and said communication
data into a personal electronic communication, wherein said personal
electronic communication comprises an e-mail message **{see, e.g., Fig. 5, ref. no. 516; p. 14, l. 21 - p. 15, l. 6; and p. 16, l. 19 - p. 17, l. 5};**

sending said personal electronic communication to said at least one recipient via said WAN **{see, e.g., Fig. 5, ref. no. 520; p. 14, l. 21 - p. 15, l. 6; and p. 16, l. 19 - p. 17, l. 5}**; and

compensating said sender by providing said sender with a free service in exchange for allowing said Web host to send said personal electronic communication, including said at least one advertisement, to said at least one recipient **{see, e.g., p. 17, ll. 8-20}**.

68. A computer-implemented method for communicating personal information, comprising the steps of:

receiving communication data and recipient data from a sender, wherein said communication data and said recipient data are used to send a personal electronic communication to at least one recipient, wherein said personal electronic communication comprising an e-mail message **{see, e.g., Fig. 3, ref. no. 304; Fig. 4, ref. nos. 406-410; Fig. 5, ref. no. 508; p. 14, l. 21 - p. 15, l. 6; p. 16, l. 19 - p. 17, l. 5}**;

using at least a portion of the content of said communication data to select at least one advertisement **{see, e.g., p. 16, l. 19 - p. 17, l. 5}**;

sending said personal electronic communication to said at least one recipient via a wide area network (WAN), wherein said personal electronic communication includes said communication data and said at least one

advertisement when it is opened by said at least one recipient **{see, e.g., Fig. 5, ref. nos. 516 and 520, p. 14, l. 21 - p. 15, l. 6; and p. 16, l. 19 - p. 17, l. 5}**; and compensating a party by providing a free service to said party in exchange for allowing said at least one advertisement to be included in said personal electronic communication, wherein said party is selected from a list consisting of said sender and said at least one recipient **{see, e.g., p. 17, ll. 8-20}**.

75. A personal communication system comprising a Web host connected to a wide area network (WAN), said Web host comprising:

a Web server adapted to communication with a plurality of network devices via said WAN **{see, e.g., Fig. 1, ref. no. 110; Fig. 2, ref. no. 112; p. 11, ll. 13-22; and p. 12, ll. 1-8}**;

a memory device connected to said Web server and adapted to store a plurality of advertisements **{see, e.g., Fig. 2, ref. no. 116; p. 12, ll. 1-4; and p. 15, ll. 7-15}**; and

an advertising application connected to said memory device **{see, e.g., Fig. 2, ref. no. 114; and p. 12, ll. 1-8}**, wherein said advertising application provides the functions of:

receiving communication data and recipient data from a sender, said communication data and said recipient data being used to send a personal communication to at least one recipient **{see, e.g., Fig. 3, ref.**

no. 304; Fig. 4, ref. nos. 406-410; Fig. 5, ref. no. 508; p. 14, l. 21 - p. 15, l. 6; p. 16, l. 19 - p. 17, l. 5};

using at least one subject matter of said communication data to select at least one of said plurality of advertisements **{see, e.g., p. 16, l. 19 - p. 17, l. 5};**

inserting said at least one of said plurality of advertisements into a personal electronic communication, wherein said personal electronic communication comprising an e-mail message **{see, e.g., Fig. 5, ref. no. 516; p. 14, l. 21 - p. 15, l. 6; and p. 16, l. 19 - p. 17, l. 5};**

sending said personal electronic communication to at least one recipient via said WAN **{see, e.g., Fig. 5, ref. no. 520; p. 14, l. 21 - p. 15, l. 6; and p. 16, l. 19 - p. 17, l. 5};** and

providing a party with a service in exchange for allowing said Web host to insert said at least one of said plurality of advertisements into said personal electronic communication, wherein said party is selected from a list consisting of said sender and said at least one recipient **{see, e.g., p. 17, l. 8-20}.**

81. A personal communication system comprising a Web host connected to a wide area network (WAN), said Web host comprising:

a Web server adapted to communication with a plurality of network devices via said WAN **{see, e.g., Fig. 1, ref. no. 110; Fig. 2, ref. no. 112; p. 11, ll. 13-22; and p. 12, ll. 1-8}**;

an advertising application connected to said Web server **{see, e.g., Fig. 2, ref. no. 114; and p. 12, ll. 1-8}**, wherein said advertising application provides the functions of:

receiving communication data and recipient data from a sender, said communication and recipient data being used by said advertising application to send a personal communication to at least one recipient, wherein said personal communication comprises an e-mail message **{see, e.g., Fig. 3, ref. no. 304; Fig. 4, ref. nos. 406-410; Fig. 5, ref. no. 508; p. 14, l. 21 - p. 15, l. 6; p. 16, l. 19 - p. 17, l. 5}**;

using at least a portion of the content of said communication data to select at least one advertisement **{see, e.g., p. 16, l. 19 - p. 17, l. 5}**;

sending said personal communication to said at least one recipient, wherein said personal communication, as viewed by said recipient, includes said communication data and said at least one advertisement **{see, e.g., Fig. 5, ref. nos. 516 and 520, p. 14, l. 21 - p. 15, l. 6; and p. 16, l. 19 - p. 17, l. 5}**; and

providing said sender with a free service in exchange for using said Web host to send said personal communication to said at least one recipient **{see, e.g., p. 17, ll. 8-20}**.

87. A personal communication system comprising a Web host connected to a wide area network (WAN), said Web host comprising:

a Web server adapted to communication with a plurality of network devices via said WAN **{see, e.g., Fig. 1, ref. no. 110; Fig. 2, ref. no. 112; p. 11, ll. 13-22; and p. 12, ll. 1-8}**;

a memory device connected to said Web server and adapted to store a plurality of advertisements **{see, e.g., Fig. 2, ref. no. 116, p. 12, ll. 1-4; and p. 15, ll. 7-15}**; and

an advertising application connected to said memory device **{see, e.g., Fig. 2, ref. no. 114; and p. 12, ll. 1-8}**, wherein said advertising application provides the functions of:

receiving sender-provided data from a sender, said sender-provided data comprising at least communication data and recipient data and being used by said advertising application to at least send a personal communication to at least one recipient, wherein said personal communication comprises an e-mail message **{see, e.g., Fig. 3, ref. no. 304; Fig. 4, ref. nos. 406-410; Fig. 5, ref. no. 508; p. 14, l. 21 - p. 15, l. 6; p. 16, l. 19 - p. 17, l. 5}**;

using at least a portion of said communication data to select at least one of said plurality of advertisements **{see, e.g., p. 16, l. 19 - p. 17, l. 5}**;

sending said personal communication to said at least one recipient, wherein said personal communication, as viewed by said recipient, includes said communication data and said at least one of said plurality of advertisements **{see, e.g., Fig. 5, ref. nos. 516 and 520; p. 14, l. 21 - p. 15, l. 6; and p. 16, l. 19 - p. 17, l. 5}**; and

providing a party with a free service in exchange for using said Web host to include said at least one of said plurality of advertisements into said personal communication, wherein said party is selected from a list consisting of said sender and said at least one recipient **{see, e.g., p. 17, ll. 8-20}**.

92. A computer-implemented method for communicating personal information, comprising the steps of:

receiving communication data and recipient data from a sender, wherein said communication data and said recipient data are used at least to send a personal communication to at least one recipient, wherein said personal communication comprises an e-mail message **{see, e.g., Fig. 3, ref. no. 304; Fig. 4, ref. nos. 406-410; Fig. 5, ref. no. 508; p. 14, l. 21 - p. 15, l. 6; p. 16, l. 19 - p. 17, l. 5}**;

using at least a portion of said communication data to automatically select at least one advertisement **{see, e.g., p. 16, l. 19 - p. 17, l. 5}**;

sending said personal communication to said at least one recipient, wherein said personal communication, as viewed by said at least one recipient, includes said at least one advertisement **{see, e.g., Fig. 5, ref. nos. 516 and 520; p. 14, l. 21 - p. 15, l. 6; and p. 16, l. 19 - p. 17, l. 5}**; and

providing said at least one recipient with a free service in exchange for using said Web host to send said personal communication to said at least one recipient **{see, e.g., p. 17, ll. 8-20}**.

Grounds of Rejection to be Reviewed on Appeal

The Appellant addresses the following issues in the arguments presented below with respect to the pending claims:

1. Whether Claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90 and 92-95 are patentable under 35 U.S.C. § 103(a) over Gabbard et al. (U.S. Pat. No. 6,205,432) ("Gabbard") in view of Roth et al. (U.S. Pat. No. 6,285,987) ("Roth").

Argument

In the Final Action, the Examiner rejected Claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90 and 92-95 under 35 U.S.C. § 103(a) for being unpatentable over Gabbard in view of Roth. These rejections should be withdrawn. This is because Gabbard and Roth do not disclose or suggest, either alone or in combination, an advertising

application that selects an advertisement for insertion into an email based on content of the email. See, e.g., Claim 62.

The rejections of Claims 65, 69, 70, 73, 76, 77, 84, 86, 88-90, 93-95 should also be withdrawn. Not only do these claims depend from Claims 62, 68, 75, 81, 87 and 92, but they include limitations that are not disclosed in or suggested by Gabbard or Roth. For example, neither reference discloses or suggests an advertising application for selecting an advertisement for insertion into an email based on (i) content of the email **and** (ii) advertisement-type data provided by a sender of the email.

I. GABBARD ET AL.

Gabbard provides a system and method for inserting a background reference to an advertisement (e.g., a watermark) into an electronic communication. According to Gabbard, the watermark is "selected in accordance with end user recipient demographic information and/or ad exposure statistics" (see Abstract). Specifically, Gabbard provides:

Based on a determination in step 408, advertisements may be selected by the background reference system 155 based on **available demographic information for a particular end user recipient** (step 414) **and/or on advertiser and advertisement exposures** (step 416). In a web-based "free" e-mail implementation, acquisition of demographic information is required before the e-mail account is provided to a user. If demographic information is not available or is otherwise inconclusive for targeted advertisements, commitments to advertisers may drive the selection from a pool of available advertisers. Of

course, as advertisements are selected based on demographic categories or exposure requirements, records are maintained for future selection and reporting purposes.

See col. 10, ll. 3-16 (emphasis added) (referencing Fig. 5). Thus, Gabbard selects a particular watermark for an email using (i) recipient demographic information and (ii) ad exposure statistics.

II. ROTH ET AL.

Roth provides an Internet advertising system, in which advertisements for web pages are auctioned off to the highest bidder. See Abstract. As shown in Figure 3, a client browser (e.g., Netscape™, Internet Explorer™, etc.) (11) is used to view a web page from a web site (14). If the web page includes an HTML reference to the web server (310), then the web server (310) provides an advertisement to the client browser (11). See, e.g., col. 6, ll. 41-45. In doing so, the web server (310) selects the advertisement from ad tables (16A) based on a highest bid received from a plurality of bidding agents (30A, 30B, 30Z). See, e.g., col. 7, ll. 19-23.

III. CLAIMS 62, 68, 75, 81, 87 AND 92

In an Office Action mailed on January 22, 2009, the Examiner rejected Claims 62, 68, 75, 81, 87 and 92 under 35 U.S.C. § 103(a) as being unpatentable over Gabbard in view of Roth. See pp. 4-6. In an Amendment dated May 21, 2009, the Appellant argued that Gabbard does not disclose “using at least a portion of the content

of said communication data to automatically select at least one advertisement from said plurality of advertisements." See pp. 13-14. The Examiner agreed, stating that "Gabbard et al fails to explicitly teach targeting advertising according to subject matter or content of the email message/body itself." See first Office Action at p. 4. The Examiner further stated, however, that such a feature is disclosed in Roth et al. ("Roth"). *Id.* The Appellant respectfully disagreed.

Roth provides an Internet advertising system, in which advertisements for web pages are auctioned off to the highest bidder. See Abstract. As shown in Figure 3, a client browser (e.g., Netscape™, Internet Explorer™, etc.) (11) is used to view a web page from a web site (14). If the web page includes an HTML reference to the web server (310), then the web server (310) provides an advertisement to the client browser (11). See, e.g., col. 6, ll. 41-45. In doing so, the web server (310) selects the advertisement from ad tables (16A) based on a highest bid received from a plurality of bidding agents (30A, 30B, 30Z). See, e.g., col. 7, ll. 19-23.

The Examiner stated that "[w]hile Roth et al. teaches advertising to appear on web pages, he nonetheless teaches that the ad chosen to be shown on that webpage can be targeted according to several factors including both demographics of the user or the keywords of the content being read by that user." See January 22, 2009 Office Action at p. 4. The Appellant respectfully disagreed. See May 21, 2009 Amendment at pp. 14-15.

Roth provides an Internet advertising system, in which advertisements for web pages are **automatically selected based on a highest bidder**. See, e.g., col. 2, ll. 54-

65 ("Next, the bid selection logic selects the highest bid from the various available bids and the advertisement which is specified in the highest bid is displayed."); and col. 7, ll. 19-23 ("After receiving input from bidding agents 30 (that is from all the bidding agents 30 that submit bids) the bid selection logic 16C in view server 320 selects the highest bid and indicates to web server 310 which advertisement should be displayed in response to the view-op.").

While Roth provides that "demographics" and "keywords" can be used, they are only used by the bidding agents to bid on advertising space. See, e.g., col. 10, ll. 33-67 and col. 11, ll. 33-37. In other words, in response to receiving an HTML reference, the view server (see Fig. 3, ref. 320) submits data to a plurality of bidding agents (30A, 30B, 30Z), including viewer data (e.g., name, email, IP info., etc.) and web page data (e.g., Owner, URL, keywords, etc.) (see col. 10, l. 33 - col. 11, l. 20). The bidding agents (30A, 30B, 30Z) use the data to bid on advertising space associated with the HTML reference. See, e.g., col. 11, ll. 33-37. For example, Nike™ may bid (via a bidding agent) 5¢ for advertising space on www.espn.com, and 1¢ for advertising space on any web page that includes the keywords "basketball" and "Michael Jordan." Thus, while keywords are provided to advertisers, they are only used to identify "words that must be in the site if a bid is to be submitted." See col. 14, ll. 21-22. The data, however, is not used by the bid selection logic (16C) to select an advertisement for the web page. That selection is based ***exclusively on the highest bid***. See, e.g., col. 2, ll. 54-65; and col. 7, ll. 19-23.

For example, Claim 62 provides an advertising application that uses content of

an email to select a particular advertisement from a plurality of advertisements (*i.e., one from many*). This feature is not disclosed in Roth. According to Roth, viewer data (*e.g.*, name, email, etc.) and web page data (*e.g.*, owner, URL, keywords, etc.) are provided to a plurality of bidding agents, or a plurality of advertisers. See, *e.g.*, col. 10, l. 33 - col. 11, l. 20. The plurality of advertisers then use this data to bid on advertising space associated with an HTML reference. See, *e.g.*, col. 11, ll. 33-37. The result is a subset of advertisers that are interested in the advertising space. Roth then selects a particular advertisement from the subset of advertisers (*i.e., one from many*) based on a highest bid. See, *e.g.*, col. 2, ll. 54-65; and col. 7, ll. 19-23.

The Examiner tries to blur the line by arguing that Roth teaches that an advertisement can be "targeted according to several factors including both demographics of the user or the keywords of the content." January 22, 2009 Office Action at p. 4. Claim 62, however, does not recite "targeting" an advertisement, but using content to select a particular advertisement from a plurality of advertisements (*i.e., one from many*) – a feature not disclosed in Roth.

Because Claim 62 is not anticipated by either Gabbard or Roth, the question becomes "whether the improvement [in Claim 62] is more than the predictable use of prior art elements according to their established function." *KRS Int'l Co. V. Teleflex Inc.*, 550 U.S. 398, 417 (2007). In the January 22, 2009 Office Action, the Examiner stated that "[g]iven the motivation provided by Gabbard et al. to seek other known advertising targeting criteria, it would have been obvious to one of ordinary skill at the time of the invention to have used the keywords (*i.e.*, subject matter, content) in Gabbard et al's

email messages so that the advertising can be more relevant to the current view-op, thus providing more effective advertising.” See first Office Action at pp. 4-5. The Appellant respectfully disagreed. See May 21, 2009 Amendment, pp. 15-18.

First, it would not have been obvious to combine Gabbard and Roth because the two references are directed toward different technologies. Gabbard provides a system for inserting an advertisement into an **email**, which is a private communication, wherein Roth provides a system for advertising on a **web page**, which is publicly accessible. Although the two systems have some similarities, they are actually quite different. For example, in Roth, web page information is not provided to the system via the client browser. Instead, it is collected beforehand and stored in data tables (see Fig. 3, Ref. 16B). This is because the web page information (e.g., URL, keyword, etc.) is public information, and can be collected and viewed by anyone, at anytime, from anywhere.

In contradistinction, email information is private information and cannot be collected or viewed beforehand. In fact, in virtually all instances, it does not even exist beforehand. Once an email is created, it is provided to an email server, where it is accepted, stored and delivered to an identified recipient. Unlike a web page, an email is a private communication between a sender and at least one recipient. As such, it cannot be accessed by the general public, but only by the intended recipient of the email. Because Roth requires web page information to be collected beforehand, and stored in data tables (16B), Roth could not function in an email environment.

Even if an email was prepared in advance, Roth does not disclose how email information would be collected. It is common knowledge that web page information is

provided in a data set referred to as "meta-data," or "meta-tags." Meta-data is data that is (1) created by the owner of the web page, (2) associated with the web page and (3) includes information on the web page (e.g., URL, keyword, etc.). See, e.g., *Horphag Research Ltd. v. Garcia*, 475 F.3d 1029, 1033 (9th Cir. 2007) ("A metatag is an indexing tool used by Internet search engines to determine which websites correspond to the search term provided by a user."). Thus, it is relatively easy for Roth to function in a web page environment. It only needs to collect predefined web page information.

Emails, however, do not generally include meta-data. To the extent they do, they most certainly do not include meta-data on "keywords," or "content meta-data." In order for Roth to function in an email environment, it would have to (1) intercept an email, (2) search for terms in the email, and (3) identify terms that are relevant – none of which are disclosed in Roth. Roth does not teach, for example, how an advertisement would be selected on an email that states "my boss has me jumping through hoops." Would Roth select an advertisement based on the keyword "boss," or would it select an advertisement based on the keywords "jumping" and "hoops?" Roth also does not teach how an email can be intercepted without violating the Electronic Communications Privacy Act of 1986 ("ECPA"), which "makes it an offense to 'intentionally intercept[], endeavor [] to intercept, or procure[] any other person to intercept or endeavor to intercept, any wire, oral, or electronic communication.'" *U.S. v. Councilman*, 418 F.3d 67, 72 (1st Cir. 2005). Because Roth requires predefined web page information (e.g., meta-data), Roth would not function in an email environment.

Second, it also would not have been obvious to take the "keyword" feature of

Roth, and include it in Gabbard. Roth provides that upon the reception of an HTML reference, previously collected keywords are retrieved from a database and provided to bidding agents, where they are used (together with additional information) to bid on advertising space. Thus, by combining the "keyword" feature of Roth with Gabbard, it would **not** result in the claimed invention. Instead, it would result (at best) in a system where data (e.g., viewer data, web page data, etc.) is provided to third party advertisers and used to bid on (or express an interest in) advertising space. There is no disclosure in either Gabbard or Roth of a system that uses content of an email (or a web page for that matter) to select a particular advertisement from a plurality of advertisements. Further, such a modified system would appear to violate the ECPA by providing private, electronic communications (or portions thereof) to third parties. See *U.S. v. Councilman*, 418 F.3d at 72.

Based on the foregoing, it is clear that Roth does not disclose "using at least a portion of the content of said communication data to automatically select at least one advertisement from said plurality of advertisements." In Roth, "keywords" are provided to bidding agent, and they are not used to select a particular advertisement from a plurality of advertisements (*i.e.*, one from many). Instead, "keywords" are used (together with additional information) to identify a plurality of advertisers that are interested in advertising space on a particular web page.

It is also clear that Roth does not suggest the foregoing limitation. As stated in the May 21, 2009 Amendment (see p. 17), any such argument would be based on impermissible hindsight. See, e.g., *KRS Int'l Co.*, 550 U.S. at 421 ("A factfinder should

be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning."); and *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 1553 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.").

The overall concept of Roth has been around for quite a while. In traditional advertising media, an advertiser would not advertise a chainsaw in a fashion magazine any more than he would advertise cosmetics in a hunting magazine. Advertisers place advertisements in mediums whose demographics are likely purchasers of their products. This advertising model, however, is not suitable for email. This is because emails from a sender to a recipient (1) vary as to subject matter, (2) are created shortly before they are sent, and (3) are considered private communications. Because of this, one skilled in the art would not have considered Roth in designing an advertising system for email. Not only would sharing information about the recipient and the content of the email to third parties be an invasion of privacy and a violation of the ECPA, but it would be unacceptable to the sender/recipient of the email. It would also require a real-time collection of relevant data (something not taught in Roth).

The Examiner responded to the foregoing arguments in the Final Action. See pp. 5-7. The following arguments were not previously provided to the Examiner.

A. Roth Does Not Use Content or Subject Matter to Select an Advertisement From a Plurality of Advertisements

In the Final Action, the Examiner stated that in Roth, content is used to select an advertisement. See p. 5. Specifically, the Examiner stated that “[a] view-op triggers an ad selection process. The ad selection process includes collecting bids where there is a match in keyword/content. The selection process also includes steps of not bidding where keywords are not matched. Content is therefore used in ad selection.” *Id.* The Appellant respectfully disagrees.

As discussed above, while Roth provides that parameters (e.g., keywords, demographics, etc.) are used to bid on (or express a level of interest in) advertising space, ***an advertisement is selected based on a highest bid received from a plurality of bidding agents***. See, e.g., col. 7, ll. 19-23. To this end, Roth provides the following example:

For example, one advertiser might have submitted a proposed bid to bidding agent 30A which specified that he is willing to pay five cents for displaying an ad to a viewer who has accessed at least three financially oriented data bases within the last week. Another advertiser might have submitted a proposed bid to bidding agent 30B specifying that he is willing to pay six cents for displaying an advertisement to a viewer that has accessed at least three financially oriented data bases with[in] the last five days. When a view-op occurs which is initiated by a viewer 10 who has accessed three financially oriented data bases in the last five days, bidding agents 30A and 30B would determine that the particular view-op satisfies the criteria specified by both advertisers. ***Both bids would be submitted to bid selection logic 16C and bid selection logic 16C would then***

select the highest bid and the advertisement specified by that advertiser would be displayed to the viewer.

See col. 4, l. 58 - col. 5, l. 19 (emphasis added). In the foregoing example, the provided data (*i.e.*, viewer data on financially oriented databases) is not used to select a particular advertisement. Instead, it is used to identify advertisers that are interested in advertising on a particular web page. The actual selection process is based exclusively on a "highest bid."

In the Final Action, the Examiner stated that in Roth "[c]ontent is ... used in ad selection." Final Action at p. 5. While it is true that viewer data and web page data (*e.g.*, keywords, etc.) are used to identify a plurality of interested advertisers, or a subset of advertisements, ***they are not used to select a particular advertisement from a plurality of advertisements.*** See Claim 62. The only criteria used to select one from many is a "highest bid." See, *e.g.*, col. 2, ll. 54-65; and col. 7, ll. 19-23. Thus, Roth does not disclose or suggest "using at least a portion of the content of said communication data to automatically select at least one advertisement from said plurality of advertisements." See Claim 62.

Claim 62 further provides the step of "inserting said at least one advertisement ... into a personal electronic communication, wherein said personal electronic communication comprises an e-mail message." In other words, after content of an email is used to select a particular advertisement from a plurality of advertisements, the particular advertisement is then inserted into the email message. This feature is not

disclosed in Roth. To the extent that Roth might use keyword data as one of the criteria to identify a subset of advertisements, the subset of advertisements are not inserted into the web page. They are provided to "bid selection logic," which selects a particular advertisement from the subset of advertisements based on "the highest bid."

B. Collecting Keyword Data Beforehand (Roth) is not Applicable to an Email Application (Gabbard)

In the May 21, 2009 Amendment, Appellant argued that it would not have been obvious to combine Gabbard and Roth because the two references are directed toward different technologies (*i.e.*, Gabbard is directed toward advertising in a **private email**, and Roth is directed toward advertising on a **public web page**). For example, in Roth, public information, which might include keyword data, is collected beforehand and stored in data tables. It is not possible to do this in Gabbard, where the content of the email is private, and only exists for a short period of time before the email is sent.

In the Final Action, the Examiner stated that "Roth et al determines webpage keywords when the view-op is created (*i.e.*, when the web page is requested by a web browser)." See p. 5. The Examiner further stated that "[t]he 5th table (VOD) is a temporary data table which is populated at the time of the view-op (10:31-37) and sent to the ad selection process (bidding agents) and is populated with freshly-retrieved data such as the user's browser type making the HTTP request (10:51), the user's IP address (10:45) and the 'keywords which appear on the site' (10:62)." The Appellant respectfully disagrees.

First, the fact that the VOD memory is populated with data when a view-op is received (see col. 10, ll. 31-36), does not mean that the data is "freshly-retrieved," as the Examiner contends. For example, the VOD memory includes information on who owns the website ("Site Owner Data") (col. 10, l. 66), minimum bid for ad space ("Site Page Ad Minimum Price") (col. 10, l. 63), advertisers ("Data About Advertisers") (col. 10, l. 55-60), and historical data ("Historic and other data from data base 16B") (col. 11, l. 3). Clearly, this information is not "freshly-retrieved," as examiner contends.

Second, Roth would not be able to function if public keyword data was not collected before hand and stored in data tables. Roth provides that when a subscribing website is viewed on a browser, two pieces of information are provided from the browser to the advertising application: (1) an HTML reference to a file on the server system; and (2) a cookie to update a data base of viewer information. See col. 4, ll. 44-57. Roth then "sends information concerning the view-op to the bidding agents 30. The information sent includes information that the server system 16 received from browser 11 and information in database 16B." See col. 4, ll. 33-38. Because keyword data is not provided by the browser, it must be stored in the database (16B). This is further supported by time constraints provided in Roth, which could only be met if keyword data is collected beforehand and stored in data tables. See, e.g., col. 5, ll. 20-24 and 46-55 ("The rate at which 'hits' on web pages occur ... can be in the order of thousands per second.").

C. While Meta-Data can be Used to Identify Keywords on a Website, it Cannot be Used to Identify Content of an Email

In the May 21, 2009 Amendment, Appellant argued that it would not have been obvious to combine Gabbard and Roth because the concept of using meta-data to retrieve keyword data from a website, cannot be used on emails.

In the Final Action, the Examiner stated that "Roth et al does not appear to explicitly state examples of how ... [it] determines keywords for a page," and that the "examiner believes one of ordinary [skill in the art] would indeed understand that a parsing technique to locate frequently occurring words would be one example." See pp. 6-7. The Examiner further stated that "[a]pplicant's claims do not require any particular technique for determining content," and that "[f]or the same reasons that no 112 § 1 [sic] rejection was made, it is assumed to be within routine skill to determine keywords/content from Roth et al." *Id.* The Appellant respectfully disagrees.

First, the Appellant is not arguing that the keyword feature in Roth is not enabled, but merely that techniques used in 1999 to identify keywords on websites could not be used to identify content of an email. Claim 62, for example, recites a particular email advertising application. Thus, the issue is whether it would have been obvious to combine a website advertising application (Roth) with an email advertising application (Gabbard). As previously discussed, it would not have been obvious because keyword meta-data was not applicable to emails.

Second, the Examiner does not dispute that it was common to use meta-data to identify keywords on a website, or that keyword meta-data was not applicable to emails.

See Final Action at pp. 6-7. Instead, the Examiner states that he "believes" that one of ordinary skill in the art in 1999 would have used "a parsing technique to locate frequently occurring words" on a website. Final Action at p. 6. What the Examiner "believes" is not proper support for a rejection.

In essence, the Examiner is taking Official Notice that such a "parsing technique" was commonly used in 1999 to identify keywords on websites. It is improper, however, to rely on Official Notice when, as here, the Appellant has "adequately traversed the examiner's assertion of official notice." See M.P.E.P. § 2144.03(A) ("It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known."); and § 2144.03(C) ("If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.").

There is ample evidence to shows that it was commonplace in 1999 to use meta-data to identify keywords on websites. See, e.g., *Niton Corp. v. Radiation Monitoring Devices, Inc.*, 27 F. Supp.2d 102, 104 (D.Mass. 1998) ("[T]he term 'META' keywords refers to keywords that are listed by the web page creator when creating the web site. An Internet user then uses a web search engine that searches the 'META' keywords and identifies a match or a 'hit.'"); see also *Paccar Inc. v. Telescan Tech., LLC*, 319 F.3d 243 (6th Cir. 2003) ("A 'metatag' is a list of words hidden in a website acting as an index or reference source identifying the content of the web site for search engines.").

There is no evidence, however, that such a technique was (or could have been) used in 1999 to identify keywords on emails. Thus, the current ground of rejection is improper.

D. It is Unclear How the Roth Keyword Feature can be Added to Gabbard Without Violating the ECPA

In the May 21, 2009 Amendment, Appellant argued that Roth does not teach how an email can be intercepted without violating the Electronic Communications Privacy Act of 1986 ("ECPA"), which "makes it an offense to 'intentionally intercept[], endeavor[] to intercept, or procure[] any other person to intercept or endeavor to intercept, any wire, oral, or electronic communication.'" *U.S. v. Councilman*, 418 F.3d 67, 72 (1st Cir. 2005).

In the Final Action, the Examiner stated that "this rejection is based on the base reference of Gabbard et al who presumably already has authority to access user's email in view of a modification based on Roth et al.." Final Action at p. 7. What the Examiner fails to appreciate is that by adding the keywords feature of Roth to the email system of Gabbard, private information (e.g., keywords, etc.) is provided to third parties via a plurality of "bidding agents." Thus, while the email system of Gabbard may be authorized to insert a watermark, that does not mean that they are authorized to distribute the email (or portions thereof) to thousands of third party advertisers. Such a system would appear to violate the ECPA.

Based on the foregoing, it is clear that neither Gabbard nor Roth disclose or suggest the limitations of Claims 62, 68, 75, 81, 87 and 92. Therefore, the rejections of

Claims 62, 68, 75, 81, 87 and 92, and the rejections of Claims 65, 69, 70, 73, 76, 77, 84, 86, 89, 90, 94 and 95, which depend therefrom, should be withdrawn.

IV. CLAIMS 88 AND 93

Claim 88 depends from Claim 87, and provides that a sender can submit "advertisement-type data" to "select a type of advertisement that can be included in said personal communication." Claim 88 further provides that the advertising application uses the "advertisement-type data" and "a portion of the communication data" (*e.g.*, content of an email, etc.) to select an advertisement from a plurality of advertisements.

In the Final Action, the Examiner stated that this feature is disclosed in Gabbard. Final Action at pp. 4-5. Specifically, the Examiner stated that "Gabbard et al's selection of particular ads targeted to the recipient and the obviousness of targeting to content can be taken to provide the feature of allowing the sender to specify ad-type data that is used to select the advertisement." *Id.* The Examiner further stated that "providing the user profile data (such as demographic information) by the user to the system is taken to address the limitation of providing advertisement-type data, as the profile information is the basis for the type of ad selected according to that user-provided information." *Id.* The Appellant respectfully disagrees.

Claim 88 provides that the sender submits (or uploads) three distinct types of data to the advertising application: (1) recipient data; (2) communication data (*e.g.*, email content, etc.); and (3) advertisement-type data. While a sender may submit "recipient data" in Gabbard, such data is not "advertisement-type data," and does not

allow "a sender to select a type of advertisement that can be included in said personal communication."

Not only can "recipient data" not be both "recipient data" and "advertisement-type data," but Gabbard does not use recipient data to select a watermark. Instead, Gabbard uses "demographic information for a particular end user recipient," which is provided by the recipient (not the sender) "before the e-mail account is provided to a user." See col. 10, ll. 3-10. In other words, to the extent that it can be argued that "demographic data" is the same as "advertisement-type data," ***such data is not provided by the sender, as claimed, but by the recipient.*** Therefore, the rejection of Claim 88, and the rejection of Claim 93, which includes similar limitations, should be withdrawn. The foregoing arguments were not previously provided to the Examiner.

V. CLAIMS 65, 69, 70, 73, 76, 77, 84, 86, 89, 90, 94 AND 95

The rejections of Claims 65, 69, 70, 73, 76, 77, 84, 89, 90, 94 and 95, which depend from the foregoing independent claims (*i.e.*, 62, 68, 75, 81, 87 and 92), should also be withdrawn. At the very least, these claims (by nature of their dependency) include the limitations of the foregoing independent claims. As discussed above, these limitations are not disclosed in, or suggested by, either Gabbard or Roth.

Conclusion

Appellant respectfully requests the reversal of the rejections of currently pending Claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90 and 92-95 and allowance of these claims forthwith, for the reasons set forth above.

Appendix

Appealed Claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90 and 92-95 are attached hereto as Appendix A. Appendix B states that there is no evidence that was entered by the Examiner and relied upon by the Appellant in the appeal. Appendix C states that the Appellant is not aware of any other appeals or interferences that would bear on the Board's decision in this appeal.

Fees

The fee for filing a brief in support of an appeal was previously paid on February 9, 2010 (see Appeal Brief filed February 9, 2010, at page 31). While the Appellant believes that no fees are due in connection with the filing of this paper, the Commissioner is authorized to charge any shortage in fees, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,

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